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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,441	11/22/2000	Steve Beck	291508005US1	2327
25096	7590	04/14/2004	EXAMINER	
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,441

Applicant(s)

BECK ET AL.

Examiner

Jeffrey D. Carlson

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 1/23/04.

Claim Objections

2. Claim 31 is objected to because of the following informalities:

- Claim 31 line 10. "message" should be replaced by --messages-- for clarity.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Claim 15 merely sets forth a data structure which is not statutory subject matter. Further, the claimed invention does not provide a useful, concrete and tangible result. In essence, the claim merely sets a forth disembodied data structure that identifies a user belonging to a group and subgroup, what conditions are associated with the group and what treatments are associated with the subgroup. The functional language which refers to how group selection was performed and steps that "will be applied" do not positively limit or further define the data. This data does not accomplish a concrete, useful

and tangible result without a processor or computer-based limitation that manipulates the data in order to select and display an ad.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarus et al (US6134532).

Regarding claim 15, Lazarus et al teaches methods and systems for analyzing user profiles upon an Internet advertising opportunity and selecting a targeted ad based on the variables in the user profile. Lazarus et al states that it is well known to provide "rule-based" ad selection. Large numbers of rules may be manually coded and evaluated to determine a selected ad for display to the user [3:9-13]. Lazarus et al teaches several variables of the user profile to be used for ad selection such as sex [20:35-37]. It would have been obvious to one of ordinary skill at the time of the invention to have provided rule-based selection logic whereby the first rule would be to evaluate the user's sex, so that the ads can be targeted using gender. Such an initial condition inherently provides balanced male and female test groups, each group being subsequently evaluated based on the subsequent hierarchy of rules. It would have been obvious to one of ordinary skill at the time of the invention to have provided any

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number of plural, nested rules to evaluate and filter identified users in subgroups so as to identify different segments of users and to associate certain ads with such user segments. For example, it would have been obvious to one of ordinary skill at the time of the invention to have tested a gender condition and then an age condition so as to identify young females, older females, young males and older males so that such subgroups/segments may receive ads more closely targeted to their subgroup/segment. Ads geared for females are taken to be in one category while ads for males are taken to be in another category. Claim 15 merely sets a forth disembodied data structure that identifies a user belonging to a group and subgroup, what conditions are associated with the group and what ad treatments are associated with the subgroup. The functional language which refers to how group selection was performed in order to define the existing group membership data and the steps that "will be applied" do not positively limit or further define the data and need not be found in the applied reference. Bear in mind that references to method limitations of "selecting without regard" and "conditions/treatments that will be applied" do not limit this data structure claim.

Regarding claims 32-34, the majority of the claim limitations are essentially optional if a user has been added to a group and subgroup. A user identified and grouped/subgrouped as a young female for targeted advertising purposes is taken to have been added to a test group and subgroup and therefore meets the claim. The balance of claim 32 and claims 33-34 specify further limitations in the case where the user has not been classified into a group and subgroup. Therefore these limitations need not be met by the above example.

Response to Arguments

7. Applicant argues that claim 15 provides a statutory claim as recited a section of the MPEP. Examiner points out that the data is non-functional descriptive material and has no interrelationship with computer software or hardware and is merely a disembodied collection of data.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-

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3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc